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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

**02/047 ART**

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on June 15, 2006

Signature

Typed or printed name Nancy Burns

Application Number

**10/646,113**

Filed

**8/22/2003**

First Named Inventor

**Bernhard JAHN**

Art Unit

**1771**

Examiner

**Salvatore, Linda**

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number **30,713**☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

Signature

**Gregory N. Clements**

Typed or printed name

**704.790.3600**

Telephone number

**June 15, 2006**

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below\*.

☒\*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Attorney Docket 02/047ART

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant	)	Bernhard Jahn et al
Application No.	)	10/646,113
Filed	)	22 August 2003
Title	)	TEXTILE FABRIC AND YARN COMPOSED OF SYNTHETIC FIBERS, PREPARATION THEREOF AND USE THEREOF
Examiner	)	Lynda Salvatore
Art Unit	)	1771

Charlotte, North Carolina  
June 15, 2006

Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450 USA

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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

This request is filed concurrently with a notice of appeal. Applicants request that a formal review of the merits of the rejection in the above-identified application occur prior to the filing of the appeal brief. Claims 16-19, 30 and 31 stand rejected under 35 U.S.C. § 103(a) as unpatentable over US 4,020,223 (Dixon) in view of US 5,397,629 (Jahn). This rejection was first set forth in the Office action mailed October 7, 2005, repeated and further explained in the final rejection mailed March 17, 2006, and further explained in the Advisory Action mailed June 1, 2006.

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## I. Request for a complete statement of rejection

Applicants first note that it is difficult to respond to the rejection as the examiner has significantly changed the facts and reasons relied upon to maintain the rejection since it was first promulgated in the Office action mailed October 7, 2005. This is most notably seen in the examiner's reliance upon column 5, lines 29-37 of Jahn for the first time in responding to applicants' arguments in the final rejection. The examiner did not restate the rejection in the final rejection so that applicants could understand how this portion of Jahn was being relied upon by the examiner in combination with the teachings of Dixon.

Applicants responded to the final rejection, inter alia, by establishing that column 5, lines 29-37 of Jahn was a mistranslation of the German priority document. See Zounek declaration filed May 3, 2006. Applicants also pointed out that there was additional disclosure in Jahn that might be relevant in determining the patentability of claims 16-19, 30 and 31 that the examiner had not relied upon, *i.e.*, the comparative example portion of Example 3 of Jahn. See response of May 3, 2006, pages 4-6. Applicants also relied upon evidence of non-obviousness at pages 6-7 of the response of May 3, 2006.

The examiner entered the Zounek declaration at page 1, section 10 of the Advisory Action but did not state whether column 5, lines 29-37 of Jahn is still relied upon as support for the rejection. In addition it now appears that the examiner is relying upon the comparative example portion of Example 3 of Jahn in support of the rejection. See Advisory Action, page 2, fourth paragraph.

Finally, the examiner did not address the arguments made in the response of May 3, 2006, based upon evidence of non-obviousness. This was error on the part of the examiner. As stated in *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986):

If a prima facie case is made in the first instance, and if applicant comes forward with reasonable rebuttal, whether buttressed by experiment, prior art references, or argument, the entire merits are to be reweighed. *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

It is believed that the arguments and evidence relied upon in the response of May 3, 2006, and those set forth *infra* establish that claims 16-19, 30 and 31 are patentable. If the conferees decide that the claims remain unpatentable, it is requested that the examiner

reopen prosecution and set forth a complete statement of the rejection including a response to the evidence of non-obviousness relied upon in the response of May 3, 2006, so applicants can determine an appropriate course of action.

## II. Dixon and Jahn do not establish a *prima facie* case of obviousness

Applicants argued in the response of May 3, 2006, that Dixon and Jahn do not suggest coating the fluorinated yarn of Dixon with a fluoropolymer. The examiner states at paragraph 2 of page 2 of the Advisory Action that the motivation for coating the fluorinated fibers of Dixon with a normal fluoropolymer is found in Jahn's disclosure that coated fibers have high slip and chemical resistant characteristics as well as soil repellency and absorbitivity properties.

Applicants respectfully disagree with the examiner's stated position. Dixon and Jahn must be read together as they would be understood by a person having ordinary skill in the art. Dixon cautions against the natural tendency workers in this field have to "equate treatment of polyolefins, polyamides, polyesters, polyacrylonitriles etc.": Dixon, column 1, lines 17-20. Dixon's disclosure of fluorinating is limited to polyolefin and polyacrylonitrile fibers. While Jahn does indicate that the fluoropolymer surface coating of that invention can be applied to synthetic fibers broadly, Jahn expresses a preference for polyesters, polyamide, or aramid fibers. Jahn, column 5, lines 62-68.

When Dixon and Jahn are read together, it is seen that Dixon cautions against equating treatment of polyolefins, polyamides, polyesters, polyacrylonitriles and is limited to fluorination of only polyolefin and polyacrylonitrile fibers while Jahn prefers to coat polyesters, polyamide, or aramid fibers with the fluoropolymer coating of that reference. The only "link" between the two references is Jahn's statement that the fluoropolymer coating of that invention may be used on "synthetic fibers." When that statement is read in light of Dixon cautioning workers in this field from equating treatments of polyolefins, polyamides, polyesters, polyacrylonitriles, the examiner's case of obviousness appears to be premised upon the impermissible "obvious to try" standard. *In re O'Farrell*, 853 F.2d 894, 903-04, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988).

Further evidence that the examiner's conclusion of obviousness is based upon an incorrect legal standard is found in the examiner's statement that "[t]here is nothing on record to evidence that the fluoropolymer coating of Jahn could not be used to coat another type of synthetic fiber such as those taught by Dixon ...." Advisory Action, page 2, third paragraph. First, that one "could" perform an act does not mean that that act would have been obvious under 35 U.S.C. § 103(a). *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Second, it is the examiner's initial burden to establish that the subject matter of the claims as a whole would have been obvious to a person of ordinary skill in the art, 35 U.S.C. § 103(a), not applicants' burden to establish that something "could not be used" as stated in the Advisory Action.

### III. Specification evidence of non-obviousness

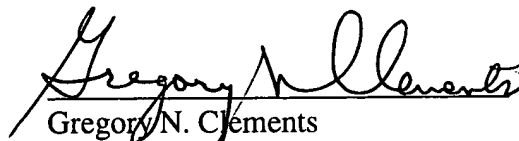
As discussed in the response of May 3, 2006, the comparative example portion of Example 3 of Jahn establishes that so-called normal fluoropolymer coatings, *i.e.*, those that are free of adhesion-promoting constituents, provide worse results when used as both the base coat and top coat coatings. It is only when a fluoropolymer containing an organic compound having a plurality of isocyanate groups is used as a base coat that adequate adhesion properties with a normal fluoropolymer top coat are obtained in Dixon. Thus, a person of ordinary skill in the art would have expected that to obtain adequate adhesion properties when using a normal fluoropolymer top coat, an adhesive base coat needs to be used. As explained in the May 3, 2006, response, the specification examples provide evidence that surface fluorination of yarn prior to coating the yarn with a fluoropolymer free of adhesion-promoting constituents unexpectedly improves the surface adhesion of the fluoropolymer to the yarn. See, e.g., Tables 1-3 and Figures 1 and 2 of the specification. As the examiner will see when the data set forth in the tables and figures are analyzed, surface fluorination of yarns prior to coating with a fluoropolymer free of adhesion-promoting constituents increases the adhesive bonding of the fluoropolymer to the yarn compared with coating a non-surface fluorinated yarn with a fluoropolymer free of adhesion-promoting constituents. Neither Dixon nor Jahn teach or suggest the results set forth in Tables 1-3 and Figures 1 and 2 of the specification.

In comparing applicants' invention with the disclosures of Dixon and Jahn, it can be seen that the present surface fluorination step is similar to the use of the fluoropolymer containing an organic compound having isocyanate groups as the base coat in Jahn. Both the surface fluorination step of the present invention and the use of the fluoropolymer containing an organic compound having isocyanate groups as the base coat in Jahn improve the adhesion of a subsequently applied fluoropolymer. In essence, what is missing from the examiner's evidence and analysis is a teaching that at the time of the present invention, a person of ordinary skill in the art understood that surface fluorination of yarns would improve the adhesion of a subsequently applied fluoropolymer that is free of adhesion-promoting constituents.

#### IV. Requested Relief

For the reasons set forth above, the examiner is respectfully asked to withdraw the rejection of record and pass the case to issue. In the alternative, if the examiner continues to believe that the claims are unpatentable, it is requested that prosecution be reopened and a new, complete statement of rejection be set forth that addresses the evidence of non-obviousness relied upon by applicants.

Respectfully submitted,

A handwritten signature in black ink, reading "Gregory N. Clements". The signature is written in a cursive style with a horizontal line underneath the name.

Gregory N. Clements  
Registration No. 30,713  
DOUGHERTY | CLEMENTS  
1901 Roxborough Road, Suite 300  
Charlotte, North Carolina 28211  
Telephone: (704) 366-6642  
Facsimile: (704) 366-9744

GNC/nb

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